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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,236	08/13/2001	Stephen F. Gass	SDT 307	8813

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EXAMINER

ASHLEY, BOYER DOLINGER

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 12/22/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,236

Applicant(s)

GASS ET AL.

Examiner

Boyer D. Ashley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 10-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 5-8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

It should be noted that for the purpose of this office action the below rejections under 35 U.S.C. 101 (double patenting) are being made under the assumption that the applications were not commonly owned at the time of applicant's invention. It should further be noted that rejections under 35 U.S.C 102(a) and 102(e) using the same U.S. Patent Applications/Publications have not been made because they do qualify as prior art as there filing dates are not before the filing date of the instant application.

Election/Restrictions

1. Applicant's election of Groups I and B (claims 1 and 3-9) in Paper No. 10 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 2 and 10-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 10.

Priority

3. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(e). See 37 CFR 1.78.

SPECIAL CIRCUMSTANCES OF THIS APPLICATION:

4. Even if a copending application is listed as a parent to the instant application and material information is technically of record in one or more parent applications, the unusually large number of applicant's cases in varying stages of the examination process might result in one or more parent applications not being readily available for review, or material information of record not being readily apparent. Applicant should point out such material information to the examiner of the instant application if the

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criteria for materiality applies, and if the examination record provides applicant reason to believe such information has not been considered by the examiner.

If, to the best of applicant's knowledge, applicant has no previous patent or copending application, which would meet the definition of "material," applicant is requested to make a statement of that fact of record.

Any parent application labeled as a CIP or Divisional is assumed to claim a patentably distinct invention from the claims of this application and therefore the issue of double patenting has not been considered and the rights to priority are limited to the common disclosed subject matter unless it is brought to the examiners attention that some claims are not distinct.

37 CFR 1.56 is cited here:

37 CFR 1.56. Duty to disclose information material to patentability.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1 and 3-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 5, 6, 7, 8, and 14-18 of copending Application No. 10/215,929, U.S. Patent Application Publication 2003/0037651. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ in claim terminology only but encompass the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1 and 3-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 12, and 16-17 of copending Application No. 10/146,527, U.S. Patent Application Publication 2002/0170400. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ in claim terminology only but encompass the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1 and 3-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 8, 14, 16-17, 19-22, 24-27, 30, and 32-34 of copending Application No. 09/929,240, U.S. Patent Application Publication 2002/0020263. Although the conflicting claims are not identical,

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they are not patentably distinct from each other because they differ in claim terminology only but encompass the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 1 and 3-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-6, and 12-14 of copending Application No. 09/929,237, U.S. Patent Application Publication 2002/0020262. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ in claim terminology only but encompass the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 1 and 3-9 are directed to an invention not patentably distinct from the claims, see above, of commonly assigned applications, for the reasons stated above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned applications, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 35 U.S.C. 103(c) and 37 CFR 1.78(c) to either show that the conflicting inventions were commonly owned at the

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time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

12. Claims 1 and 3-9 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

It is not clear who actually invented the subject matter of claims 1 and 3-9 because each of the above co-pending applications 09/929,237; 09/929,240; 10/146,527; and 10/215,929 each have different inventive entities. Therefore, it is not clear which portion of the applications where invention by the same inventive entity of the instant application.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1 and 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lokey, U.S. Patent 3,785,230, or Yoneda, U.S. Patent 4,117,752, in view of Baur, U.S. Patent 3,695,116, and Bielinski, U.S. Patent 5,606,889.

Lokey and Yoneda discloses the invention substantially as claimed, including safety brake for braking the cutting tool when a dangerous condition is detected wherein the braking is accomplished by activating the brake by a electromagnetic/solenoid; however, Lokey and Yoneda lack a braking system that includes one or more single-use components mounted in a cartridge removably coupled to the support frame.

Baur discloses that it is old and well known in the art to replace solenoids/electromagnetics with spring loaded actuators that are electrically responsive by tensioned wires for the purpose of providing fast acting, less expensive, and smaller devices that providing large mechanical forces.

Bielinski discloses that it is old and well known in the art to use spring loaded actuators that use fusible members are contained in replaceable/removable cartridges for the purpose of facilitating efficiency of the operation of the device thereby allowing the user to quickly and easily replace used cartridges with new ones.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use one or more single use components comprising fusible members that enable actuation of a braking mechanism by a spring actuator for the electromagnetic/solenoid of Lokey and Yoneda in order to provide a fast acting, less

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expensive, smaller actuator that facilitates efficiency of the operation as taught by Baur and Bielinski.

As to claim 4, the modified devices of Lokey and Yoneda both disclose firing systems for melting the fusible member, see Baur or Bielinski wherein it is disclosed that the actuators are electrically actuated for melting the fusible member, see Baur or Bielinski, wherein it is disclosed that the actuators are electrically actuated.

15. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lokey or Yoneda in view of Baur and Bielinski as applied to claims 1 and 3-4 above, and further in view of Wardlaw, U.S. Patent 5,082,316.

The modified devices of Lokey and Yoneda discloses the invention substantially as claimed except for the firing system including a capacitor; however, Wardlaw discloses that it is old and well known in the art to use capacitors with fusible element actuators for the purpose of storage energy such that when a need for the actuator occurs the actuator is more quickly actuated without worry as to any possible power failures. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a capacitor with the fusible and replaceable devices of the modified devices of Lokey and Yoneda in order to store energy for use the fusible devices such that they are more quickly actuated without worry as to power failures.

16. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lokey or Yoneda in view of Baur and Bielinski as applied to claim 1 above, and further in view of the following.

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The modified devices of Lokey and Yoneda both disclose the use of brake pawls, and springs that are selectively movable to engage the cutting tool upon detection of the dangerous condition firing systems as well as fusible members to effecting actuating of the brake by the spring; however, the brake pawls, springs and fusible members are not all mounted within the cartridge.

The examiner takes official notice that it is old and well known in the art to use to replace these brakes and spring when they are worn out or before they are worn out for the purpose of maintaining the effectiveness of the brake system of the cutting tool. The modified devices of Lokey and Yoneda disclose that it is old and well known in the art to use replaceable fusible cartridges for the purpose of providing fast acting, less expensive, and smaller devices that provide large mechanical forces. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to make the replaceable fusible cartridge devices of the modified devices of Lokey and Yoneda to include the brake spring in order to maintaining the effectiveness of the braking system.

Conclusion


17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 703-308-1845. The examiner can normally be reached on Monday-Thursday 7:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Boyer D. Ashley
Primary Examiner
Art Unit 3724

BDA
December 12, 2003